APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,748	07/15/2003	Andreas Mau	13905-020001 / 2003P00354	7407

32864	7590	03/31/2005

FISH & RICHARDSON, P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER
GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/619,748	MAU, ANDREAS
	Examiner	Art Unit	
	Martin A. Gottschalk	3626	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 July 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>07/15/2003</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 have been examined.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4, 8, 11, and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-pronged test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

3.   For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited method must somehow apply, involve, use, or advance the technological arts. In the present case, the rejected claims fail to do this. They rather recite only actions (i.e. receiving and/or transmitting things for claims 1, 4, 11, and 12), or provide a definition for a specific composition of benefits being sought (claim 8). Each of these could be

done without the use of technology, thus the claims fail to meet the first prong of the

test.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

5.   Method claims 1-24 and 26 are rejected under 35 U.S.C. 112, second paragraph

as being vague and indefinite.

A.   In exemplary claim 1, it is clear that certain pieces of information (e.g.

"requirements"; "authorization") are to be both received from an employer and

transmitted to a benefits provider(s). "Bids" however, are only received from the

benefits provider. Without a step of transmitting the bids to the employer, it is unclear

what basis an employer would have for making an authorization. Similar analysis holds

for claims 13 and 26.

B.   Claims 2-12 and 14-24 incorporate the deficiencies of claims 1 and 13

respectively, through dependency, and are therefore rejected.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1, 8, 9, 13, and 21 are rejected under 35 U.S.C. 102(b) as being

anticipated by the E-Benefits Inc. website (hereinafter E-Benefits; see the related non-

patent literature attachment pages).

A.   As per claim 1, E-Benefits discloses a method for managing employee benefits in

real-time (E-Benefits: pg. 1, second paragraph, "E-Benefits Quote Wizard brings choice

and clarity to employee benefits selection by enabling business to easily and cost

effectively select, purchase and manage employee benefits."), the method comprising:

       receiving, from an employer, requirements for benefits (E-Benefits: pg. 3, item 1.

The Examiner considers "Using search criteria that you provide…" to mean the

employer requirements (criteria), in order to be used, would have had to have been

received from the employer).

       transmitting the requirements to one or more benefits providers (E-Benefits: pg.

3, item 1. The Examiner considers E-Benefits to be a form of benefit provider. The

Examiner further considers the employer's provision of "search criteria" to be a form of

transmitting benefits requirements to a benefit provider.);

receiving bids from the one or more benefits providers to satisfy the requirements

for benefits (E-Benefits: pg. 3, item 2. The Examiner considers an employer selecting

from "available employee benefits options" to be a form of receiving bids from benefits

providers);

receiving, from the employer, an authorization to enroll benefits of a selected

benefits provider from the one or more benefits providers (E-Benefits: pg. 3, item 3.

The Examiner considers an employer completing the process of "...enrolling online with

E-Benefits..." to be a form of a benefits provider receiving an authorization to enroll

benefits of a selected benefits provider); and

transmitting the authorization to the selected benefits provider (E-Benefits: pg. 3,

item 3. The Examiner considers an employer completing the process of "...enrolling

online with E-Benefits..." to be a form of transmitting an authorization to the selected

benefits provider.).

B.   As per claim 8, E-Benefits discloses a method wherein the benefits comprise at

least one of health care benefits, life insurance benefits, savings plans, stock option

plans, pension plans, 401K plans, credit plans, flexible spending accounts, and claims

processing for flexible spending accounts (E-Benefits: pg. 2, "QuoteWizard" section.).

C.   As per claim 9. E-Benefits discloses a method wherein receiving and

transmitting are performed using a markup language (The Examiner notes that E-

Benefits is a website, and mark-up languages are commonly used to provide

functionality to websites. See for example E-Benefits: the URL of the archived web page at the bottom of pg. 3 ending in ".htm" meaning it is marked up with HTML).

D.   As per claim 13, it is an article of manufacture claim which repeats the same limitations of claim 1, the corresponding method claim, as a collection of executable instructions stored on machine readable media, as opposed to a series of process steps. Since the teachings of E-Benefits disclose the underlying process steps that constitute the method of claim 1, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim 13 are rejected for the same reasons given above for claim 1.

E.   As per claim 21, E-Benefits discloses a method wherein receiving and transmitting are performed using a markup language (The Examiner notes that E-Benefits is a website, and mark-up languages are commonly used to provide functionality to websites. See for example E-Benefits: the URL of the archived web page at the bottom of pg. 3 ending in ".htm" meaning it is marked up with HTML).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

9.   The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
      obviousness or nonobviousness.

10.   Claim 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

E-Benefits as applied to claim 1 above, and further in view of Singerman (Singerman,

Fredric S. "The Impact of the Electronic Signatures Act on Plan Administration."

Journal of Pension Benefits: Issues in Administration, Autumn 2000, Vol. 8, <u>Issue 1</u>, pp.

3-8; hereinafter Singerman).

A.   As per claim 2, E-Benefits teaches a series of steps including "Provider

Selection" and "Carrier Selection" which generate "Results". These are followed by a

"Quick Enroll" step (E-Benefits: pg. 3, see graphic at top of page) to "complete the

process" of enrolling online (E-Benefits: pg. 3, item 3.). Completion suggests the user

(employer) executing the transaction has communicated the affirmative intention to

accept the offer of (i.e. enter into contract for) the benefits package provided in the

"Results" step. Since the communication is done through a website, this acceptance

can be said to be "electronic".

However, E-Benefits fails to explicitly teach a method wherein receiving the authorization comprises receiving an electronic signature from the employer, but this feature is well known in the art as evidenced by Singerman.

Singerman discloses that Section 106 (5) of the Electronic Signature Act "defines the term 'electronic signature' to be an electronic sound, symbol, or process attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record. This could encompass...pressing 'I Accept' on a web page...The key is that the person executing the transaction intended to sign the contract (Singerman: pg. 4, section labeled "Electronic Signature)."

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Singerman into the method of E-Benefits to improve the efficiency of the enrollment process by eliminating the need for a physical signature on a paper enrollment agreement, i.e. moving toward a paperless system for plan administration (Singerman: pg. 1, col. 2, paragraph 2).

B.   As per claim 14, it is an article of manufacture claim which repeats the same limitations of claim 2, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the collective teachings of E-Benefits and Singerman disclose the underlying process steps that constitute the method of claim 2, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim 14 are rejected for the same reasons given above for claim 2.

The motivation for incorporating the teachings of Singerman into the method of

E-Benefits is as given above in the rejection of claim 2, and is incorporated herein.

11.   Claims 3, 4, 5, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over E-Benefits as applied to claim 1 above, and further in view of

MacSweeney (MacSweeney, Gregory. "Billing System Drives Cross-Sell Efforts."

Insurance & Technology, June 2003; Vol. 28, Issue 6, pg. 23; hereinafter

MacSweeney).

A.   As per claims 3, 4, and 5 E-Benefits fails to disclose a method, further

comprising:

receiving, from the employer, electronic payment for the benefits (claims 3 and

5);

receiving requests for payment for the benefits from the selected benefits

provider (claim 4); and

transmitting electronic payment for the benefits to the selected benefits provider

(claim 5).

However, these features are well known in the art as evidenced by MacSweeney.

MacSweeney discloses a benefits provider who receives electronic payment

(MacSweeney: col 2, 2nd paragraph, reads on "accepts electronic payments"; col. 3, 2nd

paragraph, note "EFT") for benefits from an employer (MacSweeney: col. 3, 2nd

paragraph. Note "customers" making the payments are "benefit administrators", which

is read on by employer.) The Examiner notes that the way EFT works is for the

customer (in this case a benefits administrator) to transmit funds electronically to a

vendor (in this case, a benefits provider) who is set up to receive electronic payments.

  MacSweeney also discloses an electronic billing system (MacSweeney: col. 2,

2nd paragraph, in particular "…a Web-based solution…that could provide customers with

the ability to edit bills electronically…"). The Examiner considers Web-based bills to be

a form of a customer (benefits administrators/employers) receiving requests for

payment from a benefit provider.

  It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the disclosures of MacSweeney with the method of E-Benefits in

order to grow revenue (MacSweeney: col. 3, last paragraph).

B. As per claims 15, 16, and 17 they are articles of manufacture claims which

repeat the same limitations of claim 3,4, and 5 respectively, the corresponding method

claims, as a collection of executable instructions stored on machine readable media as

opposed to a series of process steps. Since the collective teachings of E-Benefits and

MacSweeney disclose the underlying process steps that constitute the method of claim

3,4, and 5, it is respectfully submitted that they likewise disclose the executable

instructions that perform the steps as well. As such, the limitations of claims 15, 16, and

17 are rejected for the same reasons given above for claims 3,4, and 5 respectively.

The motivation for incorporating the teachings of MacSweeney into the method of
E-Benefits is as given above in the rejection of claims 3,4, and 5, and is incorporated
herein.

12.   Claims 6-7 and 18-19 are rejected under #5 U.S.C. 103(a) as being unpatentable
over E-Benefits and MacSweeney as applied to claims 5 and 17 above, and further in
view of Singerman.

A.   As per claim 6, the collective teachings of E-Benefits and MacSweeney fail to
disclose receiving a carrier receipt from the selected benefits provider.

However, this feature is well known in the art as evidenced by Singerman
(Singerman: pg. 6, from beginning of the section titled "DOL Authority" through the first
bulleted point of the section.). Singerman discloses a method for plan administrators to
comply with regulatory guidance concerning notification of plan participants by "using
return-receipt electronic mail...to confirm receipt of transmitted information."

It would have been obvious to one of ordinary skill in the art at the time of the
invention to combine the teachings of Singerman regarding return-receipt email with the
collective teachings of E-Benefits and MacSweeney in order to increase efficiency by
electronically providing plan participants information required by law or regulation
(Singerman: pg. 6, section titled "DOL Authority", first paragraph).

B.   As per claim 7, the collective teachings of E-Benefits and MacSweeney fail to

disclose transmitting a carrier receipt to the employer.

However, this feature is well known in the art as evidenced by Singerman

(Singerman: pg. 6, from beginning of the section titled "DOL Authority" through the first

bulleted point of the section.). Singerman discloses a method for plan administrators to

comply with regulatory guidance concerning notification of plan participants by "using

return-receipt electronic mail...to confirm receipt of transmitted information."

The motivation for combining the teachings of Singerman with the collective

teachings of E-Benefits and MacSweeney is as given above in the rejection of claim 6

and is incorporated herein.

C.   As per claims 18 and 19, they are article of manufacture claims which repeat the

same limitations of claim 6 and 7 respectively, the corresponding method claims, as a

collection of executable instructions stored on machine readable media as opposed to a

series of process steps. Since the collective teachings of E-Benefits and Singerman

disclose the underlying process steps that constitute the methods of claims 6 and 7, it is

respectfully submitted that they likewise disclose the executable instructions that

perform the steps as well. As such, the limitations of claims 18 and 19 are rejected for

the same reasons given above for claims 6 and 7 respectively.

The motivation for combining the teachings of Singerman with the collective

teachings of E-Benefits and MacSweeney is as given above in the rejection of claim 6

and is incorporated herein.

13.   Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over E-Benefits as applied to claim 1 above, and further in view of Microsoft Mastering

(Microsoft Mastering. E-Commerce Development: Business to Business. Microsoft

Press, Redmond, Washington. 2000. Ch. 6: "Overview of the Extensible Markup

Language [XML]"; hereinafter Microsoft Mastering).

A.   As per claim 10, E-Benefits fails to explicitly disclose a method wherein the

markup language comprises Extensible Markup Language (XML).

       However, this feature is well known in the art as evidenced by Microsoft

Mastering.

       Microsoft Mastering discloses the use of XML and several advantages of XML

over HTML (Microsoft Mastering: pg. 139, section on "Advantages of Using XML.")

       It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the use of XML into the method of E-Benefits in order to make

Web site development easier and more productive (Microsoft Mastering: pg. 137, 1st

paragraph.).

B.   As per claim 22, it is an article of manufacture claim which repeats the same

limitations of claim 10, the corresponding method claim, as a collection of executable

instructions stored on machine readable media as opposed to a series of process steps.

Since the collective teachings of E-Benefits and Microsoft Mastering disclose the

underlying process steps that constitute the method of claim 22, it is respectfully
submitted that they likewise disclose the executable instructions that perform the steps
as well. As such, the limitations of claim 22 are rejected for the same reasons given
above for claim 10.

The motivation for incorporating the teachings of Microsoft Mastering into the
method of E-Benefits is as given above in the rejection of claim 10, and is incorporated
herein.

14.   Claim 11, 12, 23, and 24 are rejected under 35 U.S.C. 103(a) as being
unpatentable over E-Benefits as applied to claim 1 above, and further in view of
Thompson et al (PG Pub No. 2003/0229522); hereinafter Thompson.

A.   As per claims 11 and 12, E-Benefits fails to explicitly disclose a method
comprising:

receiving, from the employer, a request to change (or stop) benefits for the
employee; and

transmitting, to the selected benefits provider, the request to change (or stop)
benefits.

However, these features are well known in the art as evidenced by Thompson.

Thompson teaches an electronic system for benefits management (Thompson:
Abstract and Fig. 1) where an employer can transmit a request to change (or stop)
employee benefits which is received by a benefits provider (Thompson: [0206]; Fig. 2A,

items 296, 300, and 302; note that request to change (or stop) employee benefits reads on "amendment request".) The Examiner considers change (or stop) requests to be specific examples of amendment requests.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method of E-Benefits with the teachings of Thompson to eliminate formerly paper-driven processes, thus improving productivity, reducing administrative expense, and improving data accuracy by removing human error (Thompson: [0012]).

B.   As per claims 23 and 24 they are articles of manufacture claims which repeat the same limitations of claims 11 and 12 respectively, the corresponding method claims, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the collective teachings of E-Benefits and Thompson disclose the underlying process steps that constitute the method of claim 11 and 12 it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claims 23 and 24 are rejected for the same reasons given above for claims 11 and 12 respectively.

The motivation for incorporating the teachings of Thompson into the method of E-Benefits is as given above in the rejection of claims 11 and 12, and is incorporated herein.

15.   Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-

Benefits as applied to claim 1 above, and further in view of Franklin et al. (PG Pub#

2004/0172268; hereinafter Franklin).

A.   As per claim 20, E-Benefits discloses a machine readable media storing

executable instructions for managing employee benefits wherein the benefits comprise

health care benefits (E-Benefits: pg. 2, "QuoteWizard" section), and claims processing

for flexible spending accounts (E-Benefits: pg. 3, "VirtualHR section" section. The

Examiner considers claims processing for flexible spending accounts to be an example

of a human resource administrative function, which the program could be customized to

perform.)

        However, E-Benefits fails to explicitly disclose the benefits comprising:

        life insurance benefits;

        flexible spending accounts;

        pension;

        401K;

        savings;

        stock options; and

        credit plans.

        However, the features are well known in the art as evidenced by the teachings of

Franklin.

Franklin discloses a machine readable media storing executable instructions for managing employee benefits wherein the benefits comprise life insurance benefits, flexible spending accounts, and pension plans (Franklin: Fig 5c). The benefits managed by the invention of Franklin further comprise savings, stock option, credit, and 401k plans (Franklin: Fig 5b. The Examiner considers a 401k plan to be a form of savings plan. Furthermore, since stock options can be one of the investment vehicles placed in a 401k plan, the Examiner considers it to be a form of stock options plan. Furthermore, since one can borrow from one's 401k plan, the Examiner considers it to be a form of credit plan.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Franklin with the invention of E-Benefits in order to consolidate all information regarding employee benefits into a single location, thus increasing customer satisfaction (Thompson: col. 2, [0010]).

16.   Claim 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits as applied to claim 1 above, and further in view of Gupta (PG Pub# 2003/0009355; hereinafter Gupta.).

A.   As per claim 25, E-Benefits discloses a system for managing employee benefits in real-time (E-Benefits: pg. 1, second paragraph, "E-Benefits Quote Wizard brings choice and clarity to employee benefits selection by enabling business to easily and

cost effectively select, purchase and manage employee benefits."), the system
comprising:

one or more computers to manage information for one or more benefits providers
(E-Benefits: pg. 3, item 1 and 2 in particular), at least one computer configured to:

receive, via a network, requirements for benefits services for an employee
(E-Benefits: pg. 3, item 1. The Examiner considers "Using search criteria that
you provide..." to mean the employer requirements (criteria), in order to be used,
would have had to have been received from the employer. The Examiner further
notes that the requirements from the employer would be for benefits for
employees. The Examiner further notes that the system of E-Benefits is Web
based, and as such, receiving and transmitting are done over a network.);

transmit the requirements, via the network, for benefits services to the one
or more of the computers managing information for one or more benefits
providers (E-Benefits: pg. 3, item 1. The Examiner considers E-Benefits to be a
form of benefit provider. The Examiner further considers the employer's
provision of "search criteria" to be a form of transmitting benefits requirements to
a computer managing information for a benefits provider.);

receive, via the network, bids to satisfy the requirements for benefits
services from the one or more computers (E-Benefits: pg. 3, item 2. The
Examiner considers an employer selecting from "available employee benefits
options" to be a form of receiving bids from benefits providers. Since the

employer is doing this from a computer connected to the Internet, the bids are

received via a network.);

receive, via the network, an authorization to enroll the services of a

selected benefits provider from the one or more computers (E-Benefits: pg. 3,

item 3. The Examiner considers an employer completing the process of

"...enrolling online with E-Benefits..." to be a form of a benefits provider receiving

an authorization to enroll benefits of a selected benefits provider via a network);

transmit the bids via the network (E-Benefits: pg. 3, item 2. The Examiner

considers an employer selecting from "available employee benefits options" to

mean the bids had been transmitted. Since the employer is performing this step

from a computer connected to the Internet, the bids are received via a network.);

transmit the authorization via the network to a computer managing

information for the selected benefits provider (E-Benefits: pg. 3, item 3. The

Examiner considers an employer completing the process of "...enrolling online

with E-Benefits..." to be a form of transmitting an authorization to the selected

benefits provider. Since the transmission is done over the Internet, it is via a

network).

E-Benefits fails to disclose:

an Enterprise Resource Planning (ERP) system to manage human

resources information for a company with employees; and

one or more computers to manage information for one or more benefits providers

(E-Benefits: pg. 3, item 1 and 2 in particular), at least one computer configured to:

receive, via a network and the ERP system, requirements for benefits

services for an employee;

receive, via the network and from the ERP system, an authorization to

enroll the services of a selected benefits provider from the one or more

computers;

transmit the bids to the ERP system via the network.

However, these features are well known in the art as evidenced by Gupta.

Gupta discloses an Enterprise Resource Planning (ERP) system to manage

employee benefits amongst a plurality of stakeholders involved in the employee benefit

process, where information is transmitted and received between them (Gupta: [0010].).

It would have been obvious at the time of the invention to combine the use of an

ERP system as disclosed by Gupta with the teachings of E-Benefits for the purpose of

reducing administrative time and costs, providing healthcare providers reimbursement in

a timely manner, and streamlining communication among the various stakeholders

involved in the employee benefit process (Gupta: [0008]).

B.   As per claim 26, E-Benefits discloses a system for managing employee benefits

in real-time (E-Benefits: pg. 1, second paragraph, "E-Benefits Quote Wizard brings

choice and clarity to employee benefits selection by enabling business to easily and

cost effectively select, purchase and manage employee benefits."), the system

comprising:

one or more computers to manage information for one or more benefits providers
(E-Benefits: pg. 3, item 1 and 2 in particular), at least one computer configured to:

obtain the requirements for benefits services for an employee (E-Benefits:
pg. 3, item 1. The Examiner considers "Using search criteria that you provide..."
to mean the employer requirements (criteria), in order to be used, would have
had to have been obtained from the employer. The Examiner further notes that
the requirements from the employer would be for benefits for employees.);

transmit, via the network, the requirements to the one or more computers
(E-Benefits: pg. 3, item 1. The Examiner considers E-Benefits to be a form of
benefit provider. The Examiner further considers the employer's provision of
"search criteria" to be a form of transmitting benefits requirements to a computer
managing information for a benefits provider.);

receive, via the network, bids to satisfy the requirements from the one or
more computers (E-Benefits: pg. 3, item 2. The Examiner considers an employer
selecting from "available employee benefits options" to be a form of receiving
bids from benefits providers. Since the employer is doing this from a computer
connected to the Internet, the bids are received via a network.);

obtain an authorization to enroll the services of a selected benefits
provider (E-Benefits: pg. 3, item 3. The Examiner considers an employer -
completing the process of "...enrolling online with E-Benefits..." to be a form of
obtaining an authorization to enroll benefits of a selected benefits provider);

transmit via the network, the authorization to a computer managing

information for the selected benefits provider (E-Benefits: pg. 3, item 3. The

Examiner considers an employer completing the process of "…enrolling online

with E-Benefits…" to be a form of transmitting an authorization to the selected

benefits provider. Since the transmission is done over the Internet, it is via a

network).

E-Benefits fails to disclose:

an Enterprise Resource Planning (ERP) system to manage human resources

information for a company with employees.

However, this feature is well known in the art as evidenced by Gupta.

Gupta discloses an Enterprise Resource Planning (ERP) system to manage

employee benefits amongst a plurality of stakeholders involved in the employee benefit

process, where information is transmitted and received between them (Gupta: [0010].).

It would have been obvious at the time of the invention to combine the use of an

ERP system as disclosed by Gupta with the teachings of E-Benefits for the purpose of

reducing administrative time and costs, providing healthcare providers reimbursement in

a timely manner, and streamlining communication among the various stakeholders

involved in the employee benefit process (Gupta: [0008]).

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The cited but not relied upon prior art discloses a method and

apparatus for providing healthcare-related information to and from a plurality of participants in the healthcare process (US Pat# 6,283,761).

18.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is 703-305-5356. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG
03/17/05

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600